APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,569	08/31/2001	Bertrand Berthelot	1807.1743	9399

5514	7590	05/04/2006

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EXAMINER
STEVENS, ROBERT

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/942,569	BERTHELOT ET AL.
	Examiner	Art Unit	
	Robert Stevens	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 February 2006</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>19-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>19-25</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: amendment filed 2/8/2006.

2.   This action is **FINAL**.

3.   The Office withdraws the previous rejections of claim 1-18 under 35 U.S.C.

§103(a), in light of the amendment canceling these claims.

4.   Claims 19-25 are pending. Claims 19, 23 and 25 are independent. Claims 1-18

have been cancelled.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.   **Claim 22 is rejected under 35 U.S.C. 112, second paragraph,** as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Regarding claim 22: This claim recites "a capacity of a software" in line 3. It is

unclear what this limitation means (especially, what the term "capacity" means in this

context).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   **Claims 19-25 are rejected under 35 U.S.C. 103(a)** as being unpatentable over

Tso (US Patent No. 6,959,318, filed Mar. 6, 1998 and issued Oct. 25, 2005, hereafter

referred to as "Tso") in view of Mäkipää et al (US Patent No. 6,556,217, filed Jun. 1,

2000 and issued Apr. 29, 2003, hereafter referred to as "Mäkipää").

Independent claim 19 states:

> *A server for providing a document via network, comprising:*
> *means for receiving characteristics related to a user terminal upon request*
> *for staring a communication;*
> *means for determining an order of processing for a transcoding of*
> *documents according to frequency of access to the documents;*
> *means for transcoding, in accordance with the characteristics related to*
> *the user terminal, the documents based on said determined order before*
> *receiving a request for access to a document;*

> *means for reading out the transcoded document upon reception of the*
> *request for access to said document; and*
> *means for sending the document read out to the user terminal.*

Tso discloses prioritizing/ordering based upon a probability that a page will be accessed at col. 7 lines 50-51, and further discusses the use of "access frequency information" to determine how popular a link is in col. 7 line 65 – col. 8 line 7. Tso further teaches transcoding some/all of the pages prior to the client requesting them in col. 6 lines 55-60. In col. 6 lines 51-56, Tso discusses the downloading of cached documents to the user, it being implied that these pages/documents are read out then transmitted. Figure 1 further discloses a full duplex communication path between client 20 and server 10 via the Internet.

However, Tso does not explicitly disclose receiving characteristics related to a user terminal upon establishing communication. Mäkipää, though, teaches the use terminal characteristics in col. 3 lines 14-20 and col. 6 lines 28-40, discussing the retrieving of terminal characteristics from a database (based upon a terminal type identified at logon). Mäkipää teaches the use of terminal characteristics for transcoding as refelected in the Mäkipää title: System and Method For Content Adaptation and Pagination Based on Terminal Capabilities.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Mäkipää for the benefit of Tso, because to do so would have allowed a user to view content regardless of the user's terminal screen size, as taught by Mäkipää in the Abstract. These references were all applicable to the same field of endeavor, i.e., transcoding of networked-served documents.

Regarding dependent claim 20, Tso discloses the use of a threshold in col. 7 lines 55-60, discussing a "cut off probability" (i.e., a threshold). Tso further discloses further discusses the use of "access frequency information" to determine how popular a link is in col. 7 line 65 – col. 8 line 7.

Regarding dependent claim 21, Tso teaches transcoding all server documents in col. 6 lines 49-60, discussing transcoding of all documents by the server, and further indicating that processing "some" documents would also have been well-known in the art.

Regarding dependent claim 22, Tso does not explicitly disclose use of a user terminal characteristic such as screen size. Mäkipää, though, teaches use of terminal screen size data in the Abstract and col. 3 lines 14-19, discussing calculation of display space based upon user terminal screen size.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Mäkipää for the benefit of Tso, because to do so would have allowed a user to view content regardless of the user's terminal screen size, as taught by Mäkipää in the Abstract. These references were all applicable to the same field of endeavor, i.e., transcoding of networked-served documents.

Independent claim 23 is directed to a method implemented by the means of the

server of independent claim 1. As such, this claim is substantially similar to claim 1 and

likewise rejected.

Claim 24 is directed to a computer readable medium storing a program to

implement the method of claim 23. As such, this claim is substantially similar to claim

23 and likewise rejected.

Independent claim 25 states:

*A method of providing content of documents from a server via a network,
comprising the steps of:*
        *receiving an initial access request from a client, said initial access request
beginning a communication session;*
        acquiring at least one characteristic from the initial access request;
        *transcoding at least one first content into a second content according to
said at least one characteristic, said transcoding of said first content taking place
before a reception of a request for access to said first content;*
        receiving a request for access to a first content from said client; and
        *sending the second content corresponding to the requested first content to
the client.*

Tso discloses prioritizing/ordering based upon a probability that a page will be

accessed at col. 7 lines 50-51, and further discusses the use of "access frequency

information" to determine how popular a link is in col. 7 line 65 – col. 8 line 7. Tso

further teaches transcoding some/all of the pages prior to the client requesting them in

col. 6 lines 55-60. In col. 6 lines 51-56, Tso discusses the downloading of cached

documents to the user, it being implied that these pages/documents are read out then

transmitted. Figure 1 further discloses a full duplex communication path between client 20 and server 10 via the Internet.

However, Tso does not explicitly disclose receiving characteristics related to a user terminal upon establishing communication. Mäkipää, though, teaches the use terminal characteristics in col. 3 lines 14-20 and col. 6 lines 28-40, discussing the retrieving of terminal characteristics from a database (based upon a terminal type identified at logon). That is, when the user establishes a communication session, the terminal type is identified. Mäkipää teaches the use of terminal characteristics for transcoding as refelected in the Mäkipää title: System and Method For Content Adaptation and Pagination Based on Terminal Capabilities.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Mäkipää for the benefit of Tso, because to do so would have allowed a user to view content regardless of the user's terminal screen size, as taught by Mäkipää in the Abstract. These references were all applicable to the same field of endeavor, i.e., transcoding of networked-served documents.

Response to Arguments

9.   Applicant's arguments have been fully considered but they are not persuasive. It is noted that the amendment, including cancellation of previous claims, substantially changes the scope of the claimed subject matter.

Applicant argues that, in the context of the now cancelled claims, that the Tso

and Dutta references are deficient. In regards to Dutta, these arguments are

considered moot, since Dutta is no longer being cited. In regards to Tso, Applicant

asserts Tso does not explicitly teach the use of terminal characteristics in a transcoding

process. The Office notes that the current rejections cite the Mäkipää reference as

explicitly teaching this limitation.

For these reasons, the Office maintains/asserts the rejections under 35 USC

103(a) as set forth above.

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

US Patents

Desai et al	6,871,218
Dodrill et al	6,990,514
Hirose et al	6,973,619
Whitledge et al	6,925,595
Wanderski et al	6,519,617
Jamtgaard et al	6,430,624
Schneider	6,944,658

12. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Robert Stevens whose telephone number is (571) 272-

4102. The examiner can normally be reached on M-F 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather R. Herndon can be reached on (571) 272-4136. The current fax

phone number for the organization where this application or proceeding is assigned is

703-872-9306. Additionally, the main number for Technology Center 2100 is (571) 272-

2100.

   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Robert Stevens
Art Unit 2176
Date: April 25, 2006

rs

WILLIAM BASHORE
PRIMARY EXAMINER
4/28/2006